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| APPLICATION NO.   | FILING DATE        | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                                | CONFIRMATION NO.                               |
|---|--------------------|----------------------|--|--|
| 10/714,101  | 11/14/2003         | Craig Partridge      | 02-4122  | 9540   |
| 25537<br>VERIZON<br>PATENT MANAGEMENT GROUP<br>1320 North Court House Road<br>9th Floor<br>ARLINGTON, VA 22201-2909 | 7590<br>12/15/2009 |                      | <div>EXAMINER</div> <div>ZIA, SYED</div>           |  |
|   |                    |                      | <div>ART UNIT</div> <div>2431</div>                | <div>PAPER NUMBER</div>                        |
|   |                    |                      | <div>NOTIFICATION DATE</div> <div>12/15/2009</div> | <div>DELIVERY MODE</div> <div>ELECTRONIC</div> |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

### Office Action Summary

**Application No.**

10/714,101

**Applicant(s)**

PARTRIDGE ET AL.

**Examiner**

SYED ZIA

**Art Unit**

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 2, 4-13, 15-17, 22, 24-25, 29, 31-40, 42-44, 49, 51, 52, 56, 58-67, 69-71, 76, 78, and 79 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 2, 4-13, 15-17, 22, 24-25, 29, 31-40, 42-44, 49, 51, 52, 56, 58-67, 69-71, 76, 78 and 79 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date \_\_\_\_\_

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to remarks file on May 18, 2009. The amendment filed have been entered and made of record. Claims 2, 4-13, 15-17, 22, 24-25, 29, 31-40, 42-44, 49, 51, 52, 56, 58-67, 69-71, 76, 78, and 79 are pending for consideration.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2, 4-13, 15-17, 22, and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims "a computing device programmed". This is not clear what does this limitation mean in the context of claim language. Disclosure is silent regarding this term.

Claim 56, 58-67, 69-71, 76, 78-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims "a tangible computer-readable medium". Disclosure is silent regarding this description of this term. For examining purposes examiner assumed "a computer-readable medium".

***Claim Rejections - 35 USC § 101***

Claims 2, 4-13, 15-17, 22, 24-25, 56, 58-67, 69-71, 76, and 78-79 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

1. Claims 2, 4-13, 15-17, 22, and 24-25 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory, because the mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

2. Claims 56, 58-67, 69-71, 76, and 78-79 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer readable media may

have a form of energy, such as carrier waves (please refer paragraph [0095] of disclosure), therefore, instruction are not necessarily in executable form to accomplish practical application because it lacks storage medium which enables any underlying functionality to occur, therefore, claims are directed to non-statutory subject matter

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SYED ZIA whose telephone number is (571)272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sz

November 30, 2009

/Syed Zia/

Primary Examiner, Art Unit 2431